

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

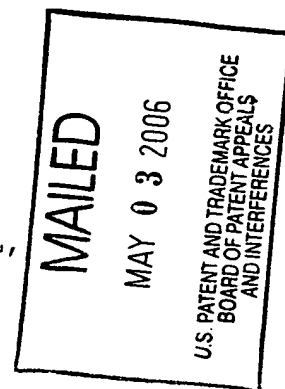
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAMES FRANCIS ULRICH, NEAL TORREY JAKEL,
DANIEL JEFFREY DYER and THOMAS LOHRMANN

Appeal No. 2006-0781
Application No. 09/637,843

ON BRIEF



Before WALTZ, KRATZ, and TIMM, *Administrative Patent Judges*.
WALTZ, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal from the primary examiner's final rejection of claims 1 through 25 and 73, which are the only claims pending in this application. We have jurisdiction pursuant to 35 U.S.C. § 134.

According to appellants, the invention is directed to a feed ration comprising a corn meal obtained after extraction of oil from whole high oil corn, with at least one other nutrient (Brief, page 2). Claim 1 on appeal is illustrative of the invention and is reproduced below:

1. A feed ration comprising:
a corn meal obtained after extraction of oil from
whole high oil corn and at least one other nutrient.

The examiner has relied upon the following prior art
references as evidence of obviousness:

Morrison, *Feeds and Feeding*, pp. 424-25, 523-25, 1116-19, 1124 and
1128, 22nd ed., The Morrison Publishing Co., Ithaca, N.Y., 1957;

Watson et al. (Watson), *Corn: Chemistry and Technology*, pp. 45-46,
313-16, 351-58, 360-66, 370-71, 408, 447-66 and 474, American
Assoc. of Cereal Chemists, Inc., St. Paul, Minn., 1994.

The claims on appeal stand rejected under 35 U.S.C. § 103(a)
as unpatentable over Watson in view of Morrison (Answer, page 4).¹

Based on the totality of this record, we *affirm* the examiner's
rejection on appeal for those reasons set forth below.

¹As correctly noted by appellants (Reply Brief, page 2),
portions of the Answer are contradictory in that the examiner
states that the "rejection of the claims under 35 USC 103 was
dropped in the Advisory Action" leaving only a requirement for
applicants to resolve the "joint inventors" issue (Answer, page
3, ¶(6)) while the Advisory Action dated May 23, 2005, and the
Answer (page 4, ¶(9)) state that the claims on appeal remain
rejected under § 103(a). However, since appellants are aware
that the examiner has withdrawn all of the rejections under
§ 103(a) *except* the rejection over Watson in view of Morrison
(Reply Brief, page 2) and the examiner has positively repeated
the rejection on appeal (Answer, page 4, ¶(9); see also the
Advisory Action dated May 23, 2005), we hold these contradictory
statements to be harmless error. The "joint inventors" issue is
moot since the examiner has withdrawn the rejection over Ulrich,
U.S. 6,723,370 (Reply Brief, pages 2-3).

OPINION

The examiner finds that Watson discloses high oil corn, the concept of using high oil corn in place of regular corn in animal feeding, milling of corn into corn meal, extraction and separation of fat (oil) from corn meal, the use of corn meal with other nutrients in food, as well as the fat content and proximate analysis of corn meal (Answer, pages 4-5). The examiner applies Morrison to show that it was well known in this art to use corn meal in animal feeds, the use of other nutrients with corn meal, and the use of corn meal in poultry, swine, equine and cattle feeds (Answer, page 5).

Appellants argue that the examiner has ignored an element of each independent claim that the corn meal product is obtained after extraction from "whole high oil corn" (Brief, page 5; Reply Brief, page 3). Appellants also argue that the examiner has ignored another element from each claim, i.e., "extracting oil from the whole corn" (Brief, page 6; Reply Brief, page 3). Appellants further argue that Watson does not disclose oil extraction from whole corn but teaches oil extraction occurs only after separation of the germ (Brief, pages 6-7). Appellants argue that, since Morrison does not state otherwise, his corn meal must be produced according to the standard method used in the art, namely after

separation of the germ from the endosperm (Brief, page 7).

Finally, appellants argue that, even if the disclosures of Watson and Morrison were combined, one of ordinary skill in the art would still extract oil from only the germ of corn, either No. 2 yellow corn or high oil corn (*id.*).

Appellants' arguments are not persuasive. As correctly stated by the examiner (Answer, page 6), the claims are written in product-by-process format. In such a claim format, it is the patentability of the *products* defined by the claims, and not the processes for making them, which must be gauged in light of the prior art. See *In re Wertheim*, 541 F.2d 257, 271, 191 USPQ 90, 103 (CCPA 1976); see also *In re Hirao*, 535 F.2d 67, 69, 190 USPQ 15, 17 (CCPA 1976). As stated by a predecessor of our reviewing court:

It must be admitted, however, that the lack of a physical description in a product-by-process claim makes determination of the patentability of the claim more difficult, since in spite of the fact that the claim may recite only process limitations, it is the patentability of the *product* claimed and *not* of the recited process steps which must be established. We are therefore of the opinion that, when the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claimed in a product-by-process claim, a rejection based alternatively on either section 102 or section 103 of the statute is eminently fair and acceptable. As a practical matter, the Patent Office is not equipped to manufacture products by the myriad of processes put before it and then obtain prior art products and make physical comparisons therewith. *In re Brown*, 459 F.2d 531, 535, 173 USPQ 685, 688 (CCPA 1972).

"In *Brown*, the court was in effect saying that the Patent Office bears a lesser burden of proof in making out a case of prima facie obviousness for product-by-process claims because of their peculiar nature than would be the case when a product is claimed in the more conventional fashion." *In re Fessman*, 489 F.2d 742, 744, 180 USPQ 324, 326 (CCPA 1974).

We determine that the disclosure of Watson provides a reasonable belief that the corm meal product of the claimed feed ration is the same or substantially similar to the corn meal product taught by Watson. Therefore the burden of proof has been shifted to appellants to establish, through objective evidence, that the product of the claimed subject matter differs in an unobvious manner from the product of the prior art (Watson). See *In re Brown, supra*; *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433-34 (CCPA 1977); and *Ex parte Phillips*, 28 USPQ2d 1302, 1303 (Bd. Pat. App. & Int. 1993).

Appellants' principal arguments are directed to differences in the *process* steps of making the claimed product as compared to the prior art product, but it is the *product* which is claimed (see the arguments regarding "extraction of oil" from a "whole high oil corn" as the starting material as discussed above). Appellants' only argument concerning the product argues that the process steps

"affect the type of product obtained" (Reply Brief, page 3).

However, appellants have not submitted any objective evidence to substantiate this argument that the corn meal derived from whole high oil corn with the oil partially extracted differs substantially from the corn meal derived from low oil corn that has been cracked or separated. See *In re Scarborough*, 500 F.2d 560, 566, 182 USPQ 298, 302 (CCPA 1974) (generally held that attorney argument is insufficient to take the place of evidence or expert testimony).

We determine that Watson discloses the proximate analysis of various standard corn meals which are the same or substantially similar to the analysis of appellants' corn meal product. Compare, for example, the typical composition of dry-milled corn meal (standard meal) as disclosed by Watson in Table VII on page 371 or the typical composition of corn cones (a very fine, uniform corn meal) in Table III on page 356 with the corn meal compositions as claimed in claims 16 and 24. We discern no difference in the overlapping ranges of every component in the corn meal compositions of Watson (Table VII) and appellants' corn meal compositions. See *In re Peterson*, 315 F.2d 1325, 1329-30, 65 USPQ2d 1379, 1382 (Fed. Cir. 2003). Accordingly, we determine that the disclosure of Watson establishes a reasonable belief that the products of Watson

and appellants are the same or substantially similar. See *In re Brown, supra*.

For the foregoing reasons, we determine that a prima facie case of obviousness has been established by the reference evidence.² Based on the totality of the record, including due consideration of appellants' arguments, we determine that the preponderance of evidence weighs most heavily in favor of obviousness within the meaning of § 103(a). Therefore we agree with the examiner's conclusion of obviousness and affirm the rejection of the claims on appeal under § 103(a) over Watson in view of Morrison.

²Morrison was applied by the examiner primarily to show the obviousness of several dependent claim limitations (Answer, page 5). However, since appellants only present reasonably specific, substantive arguments regarding the independent claims (claims 1, 16, 17 and 19; Brief, page 5), a discussion of Morrison is unnecessary to this decision.

AFFIRMED

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